

Remarks

1. Summary of Office Action

In the final office action, the Examiner maintained rejections of claims 1-9, 14-18, and 21-24 under 35 U.S.C. § 103(a) as being obvious over a combination of U.S. Patent No. 6,345,095 (Yamartino) and U.S. Patent No. 6,292,557 (Gabara).

2. The Claimed Invention

Pending in this application are claims 1-9, 14-18, and 21-24, of which claims 1, 5, 15, 21, 22, and 24 are independent and the remainder are dependent.

Each of Applicant's claims includes (expressly or through dependency) the functions of determining whether digits entered by a user match digits at the end of any telephone number in a phone book, and, if the determination is that the entered digits do not match digits at the end of any telephone number in the phone book, then automatically pre-pending digits to the entered digits so as to produce a composite telephone number. Further, all of Applicant's claims other than claim 24 also include the function that if the determination is that the entered digits match digits at the end of a telephone number in the phone book, then a call is initiated to that number.

These features are clearly understood from Applicant's specification, which explains that a phone book search would look for a telephone number whose last digits match those dialed by the user, and that the subscriber terminal may automatically add a stored set of digits to an entered number if the entered number does not match the ending digits of any entry in the phone book. (See, e.g., page 6, lines 1-3; page 7, line 22 – page 8, line 4). Moreover, Figure 4 of the application as filed illustrates that a determination is made as to whether the entered digits match the last digits of a phone book entry (see block 64) and, (a) if the determination is that the entered digits do not match the last digits of any phone book entry, then a predefined digit

sequence is added to the number to generate the composite number (see blocks 74, 76, 80 and 82), but (b) if the determination is that the entered digits match the last digits of a given phone book entry, then the full number listed in that phone book entry is used to initiate the call (see blocks 90 and 84).

3. Response to Claim Rejections

The combination of Yamartino and Gabara fails to render obvious Applicant's claimed invention, at a minimum because the combination does not disclose or suggest the claimed functions of (i) determining whether digits entered by a user match digits at the end of any telephone number in a phone book and (ii) pre-pending digits in response to determination being that the entered digits do not match digits at the end of any telephone number in the phone book.

In the final office action, the Examiner suggested a stepwise combination of references, asserting that (i) according to Yamartino, a system would first determine that an entered telephone number does not match any number in a phone book, and (ii) according to Gabara, the system would then determine that the exchange prefix of the entered telephone number does not match an exchange prefix in an area code directory, and the system would then responsively pre-pend an area code to the entered digits.

Even assuming, for sake of discussion, that the Examiner's proposed combination would have been obvious, the combination still fails to constitute Applicant's claimed invention. In particular, the combination still fails to suggest the claim function of determining whether entered digits match digits at the end of any number in a phone book. By necessity, the combination therefore also fails to suggest the claim function of pre-pending in response to a determination that the entered digits do not match digits at the end of any number in the phone book.

At best, Yamartino and Gabara (and thus the combination) are directed to specific forms of automated telephone number generation, but the combination fails to amount to the invention as recited in Applicant's claims. By way of example, although (as the Examiner put it) "Yamartino discloses a system intended to provide complete phone numbers to callers entering in partial digits" (*see* page 7 of the final office action), Yamartino does not suggest doing so in response to a determination that entered digits do not match digits at the end of any number in a phone book.

Further, the act of pre-pending in response to a finding that an entered telephone number is not in a phone book (as the Examiner suggested Gabara would do) does not amount to pre-pending in response to the entered digits not matching digits **at the end** of any number in a phone book as presently claimed. An entered telephone number could fail to match any number in a phone book simply because the entered telephone number has a prefix that does not match the prefix of any number in the phone book, regardless of whether the entered digits match ending digits of any number in the phone book.

Any suggestion to consider whether entered digits match digits at the end of a number in the phone book comes only from Applicant's claims, not from Yamartino and Gabara. Consequently, the Examiner's obviousness rejection is improper, not only because the cited references do not suggest Applicant's claimed invention, but also because the Examiner has applied impermissible hindsight analysis, using Applicant's claims as a blueprint to modify the prior art. *See Holdosh v. Block Drug Co.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986) ("the references must be viewed without the benefit of hindsight vision afforded by the claimed invention.")

Indeed, if a person of ordinary skill level were to combine the teachings of Yamartino and Gabara, the person would achieve something very different than Applicant's claimed

invention. At best, a system resulting from the combination would operate to (i) determine that digits at the beginning of an entered number are invalid or not present and (ii) responsively use (or propose to use) other digits at the beginning of the entered number. In particular, using the teachings of Yamartino, the system would determine that an area code (and perhaps exchange code) at the beginning of the number is invalid or not present and would responsively propose using one or more predefined area codes (and perhaps exchange codes) to produce a valid telephone number. (See Yamartino at column 9, lines 11-35; column 9, line 64 – column 10, line 15). Similarly, using the teachings of Gabara, the combination would determine that an exchange code at the beginning of the entered number is not found in an exchange code directory and would responsively add a default area code to the number. (See Gabara, at column 6, lines 32-36).

In addition, to the extent Applicant's claims recite both a determination function and two possible resulting functions, selected depending upon the result of the determination function, the cited combination further fails to suggest the claimed invention. As noted above, all of Applicant's claims except claim 24 require determining whether entered digits match digits at the end of any telephone number in a phone book **and** (i) if so, then dialing out a call to the telephone number, or (ii) if not, then automatically pre-pending digits to the entered digits, to produce a composite number, and dialing out a call to the composite telephone number. The cited combination of Yamartino and Gabara fails to teach the recited determining function followed by the recited functions that depend on the result of the determination.

Under M.P.E.P. § 2143, a *prima facie* case of obviousness of a claim over a combination of references can be established only if the references disclose or suggest every limitation of the claim. Because the combination of Yamartino and Gabara fails to disclose or suggest at least the

function of pre-pending digits to entered digits in response to a determination that the entered digits do not match the digits at the end of any number in the phone book, *prima facie* obviousness of Applicant's claims over Yamartino and Gabara does not exist.

4. Interview Summary

The undersigned and the Examiner held a telephone interview on May 31, 2005, and we continued the interview on June 7, 2005. Applicant thanks the Examiner for his time and consideration of this matter.

During the interview, the Examiner asserted that the limitation of *pre-pending in response to a determination that the entered digits do not match digits at the end of any number in the phone book* is **not** taught by either Yamartino or Gabara. However, the Examiner expressed his belief that, if Yamartino and Gabara were to be combined, the limitation would result. In particular, the Examiner asserted that the limitation is a series of steps carried out on an entered number, and Examiner stated that *it seems* like those steps would be in the combination.

The Examiner further asserted that in his view, the *only possible result* of combining Yamartino and Gabara together would be Applicant's claimed invention. As explained above, however, Applicant disagrees. It is quite possible, and indeed likely, that combining Yamartino and Gabara together would result in something very different than what Applicant claims.

The undersigned explained that, for reasons set forth above, the combination of Yamartino and Gabara does not suggest Applicant's claimed invention. In particular, the undersigned emphasized that each of Applicant's claims recite a specific combination of elements that is neither disclosed nor suggested by the combination of Yamartino and Gabara.

5. Conclusion

According to M.P.E.P. § 2143.01, the mere fact that references can be modified does not render the resulting modification obvious unless the prior art also suggests the desirability of the modification. (Citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992)). In this case, there is no suggestion in the cited art to modify the teachings of Yamartino and Gabara so as to achieve the invention specifically recited in Applicant's claims. Therefore, the mere fact that the Examiner believes the references can somehow be modified to achieve Applicant's claimed invention does not render the resulting modification obvious.

For the foregoing reasons, Applicant respectfully requests favorable reconsideration and allowance of the pending claims. If the Examiner has any questions, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

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